

## **REMARKS**

### **I. Introduction**

Claims 14-16, 40-48, and 69-80 are pending in this application.

In the Non-Final Office Action dated July 13, 2007 ("Action"), claims 14, 16, 40, 42, 43, 45, 46, and 48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zigmond et al. U.S. Patent No. 6,698,020 ("Zigmond") in view of Mori Japanese Patent No. JP 410162484 A ("Mori") and Aoyama et al. Japanese Patent No. JP 408076778A ("Aoyama")<sup>1</sup>. Claims 15, 41, 44, and 47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zigmond in view of Mori, Aoyama, and Hite et al U.S. Patent No. 6,002,393 ("Hite"). Claims 69, 71, 72, 74, 75, 77, 78, and 80 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zigmond in view of Mori and Russo et al. U.S. Patent No. 5,619,247 ("Russo"). Finally, claims 70, 73, 76, and 79 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zigmond in view of Mori, Russo, and Hite.

The Examiner's claim rejections are respectfully traversed.

### **II. Claims 14-16 and 40-48**

Claims 14, 16, 40, 42, 43, 45, 46, and 48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zigmond in view of Mori and Aoyama. Claims 15, 41, 44, and 47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zigmond in view of Mori, Aoyama, and Hite. These rejections are respectfully traversed.

Generally speaking, each of independent claims 14, 40, 43, and 46 is directed toward presenting a forced advertisement on user equipment. The user equipment automatically presents the forced advertisement from the beginning of the forced advertisement when the user equipment is turned back on after the user equipment is turned off while the forced advertisement is being presented on the user equipment.

---

<sup>1</sup> Mori and Aoyama are Japanese Language references and the Examiner only provided an English language translation of the Abstract for each. Furthermore, reference was not made in the Office Action to the full text of Mori or Aoyama. Therefore, in accordance with MPEP § 706.02 (II), the evidence relied upon in this response is the facts contained in the Abstract, not additional facts that may be contained in the underlying full texts. Applicant hereby reserves the right to submit additional arguments in view of the full text if applicant deems it necessary.

Zigmond describes selecting and inserting advertisements into a video programming feed. To address advertisement avoidance by "aggressive channel surfers," Zigmond inserts a particular advertisement into each advertisement slot that a channel surfer encounters, or alternatively, simultaneously broadcasts a selected advertisement on all channels. See Zigmond, column 13, ll. 16-39.

Mori describes a "CD reproducing device" which is able to resume reproducing from a "reproducing interrupted spot" without any time delay when a power source is switched ON again after the power source is switched OFF (Mori, Abstract).

Aoyama describes a video Karaoke system that displays an advertisement when the system is not being used to play Karaoke. When the system receives a request to play Karaoke music while an advertisement is being presented, the advertisement is interrupted and the Karaoke music is played. After the karaoke music is ended, the advertisement is replayed from the beginning. (Aoyama, Abstract).

Zigmond, Mori, and Aoyama, taken individually or in combination, fail to teach or suggest turning off user equipment on which a forced advertisement is being presented and automatically presenting the forced advertisement from the beginning of the forced advertisement when the user equipment is turned back on. The Examiner concedes that Zigmond fails to teach this subject matter (see Office Action, p. 3, ll. 3-6) and relies on Mori and Aoyama to make up for this acknowledged deficiency. In particular, the Examiner contends that the resuming features of Mori and Aoyama can be combined with Zigmond to produce the claimed invention. Applicant disagrees.

First, the Examiner erroneously asserts that "Mori teaches...turning off the user equipment while the forced advertisement is being displayed" and automatically resuming. Office Action, page 3, lines 7-9. As described above, Mori describes a "CD reproducing" system, not a system for displaying forced advertisements. By glossing over this important distinction, the Action fails to address how one of ordinary skill in the art would bridge this logical and functional gap between Mori, intended for "reproducing" CDs, and Zigmond intended for targeting advertisements. The Action's conclusory statement that the combination would "enable the device to present an entire program even after power loss" fails to address this

issue. In particular, it is just as likely for the modified system to resume replaying programs after a power loss without extending this functionality to the advertising aspect of Zigmond.

Second, Zigmond, Aoyama, and Mori cannot be combined because they teach away from their combination. Furthermore, even if the references could be combined, which they could not, the resulting combination would not produce the claimed invention. Detailed arguments in support of Applicant's position follow.

A. Aoyama and Zigmond Cannot be Combined

First, Aoyama and Zigmond cannot be combined because they teach away from their combination (see MPEP § 2145 (X)(D)(2)). In particular, Zigmond describes a system which prevents a viewer from avoiding an advertisement by changing channels. In keeping with this principle, Zigmond requires that the viewer be presented with the particular advertisement as the viewer progresses through the channel lineup so that the viewer is "repeatedly exposed to at least bits and pieces of the one particular advertisement." (See Zigmond, column 13, ll. 28-39). In contrast, Aoyama describes a Karaoke system that presents advertisements when the system is not being used for Karaoke. Accordingly, Aoyama requires that the viewer be allowed to interrupt an advertisement upon request in order to use the system for Karaoke. Therefore, modifying Zigmond, in the manner suggested by the Examiner, to include the voluntary interruption and resuming feature taught by Aoyama would require permitting an aggressive channel surfer to view other programs on an intervening basis with the advertisement, in direct contrast with the teachings and principles of Zigmond. According to the MPEP, when modifying prior art for the purposes of a § 103 rejection, the "proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference." MPEP § 2143.01. Because Aoyama cannot be combined with Zigmond without changing the principle of operation of at least Zigmond, the combination is improper and cannot form the basis of a § 103 rejection. Therefore, the § 103 rejection of claims 14, 40, 43, and 46 should be reconsidered and withdrawn for this reason alone.

B. Aoyama and Mori Cannot be Combined

Second, Aoyama and Mori also cannot be combined for similar reasons. Mori is intended

"[t]o smoothly resume reproducing from a reproducing interrupted spot without any time delay when a power source is switched ON again after the power source is switched OFF in a video CD reproducing device." (Mori, Abstract, emphasis added). In contrast, Aoyama requires that an interrupted advertisement video be "continuously displayed from the first to the last at the time" when the Karaoke music has ended. (Aoyama, Abstract). Therefore, even assuming *arguendo*, that a combination of the CD system in Mori and the Karaoke system in Aoyama would be technologically feasible, the two references cannot be combined because they teach away from their combination. Whereas Mori would require that an interrupted advertisement resume at the point of interruption, Aoyama would require that the advertisement be resumed from the beginning. Therefore, the references cannot be combined without eviscerating the spirit of one or the other. As set forth above, a combination of references is improper where the proposed modification changes the principle of operation of a reference (see MPEP § 2143.01). Therefore, the § 103 rejection of claims 14, 40, 43, and 46 should be reconsidered and withdrawn for this additional reason.

C. The Alleged Combination of Zigmond, Mori, and Aoyama, Even if Proper, Would Not Produce the Claimed Invention

Finally, even if Zigmond, Mori, and Aoyama could be combined, which they could not, such a combination would not produce the claimed invention as set forth in independent claims 14, 40, 43, and 46. Specifically, the combination of Zigmond and Mori would at best result in a system that allows a viewer to resume an interrupted advertisement from the point of interruption after the system is turned off and on. The addition of Aoyama would at best only allow such a system to (1) interrupt an advertisement in response to a user request to play Karaoke and (2) replay the advertisement from the beginning after the Karaoke is ended. The combined system, however, would not resume an advertisement from the beginning when the system on which it was being presented is turned off and then on, as is specified in independent claims 14, 40, 43, and 46.

Thus, Zigmond, Mori, and Aoyama, taken individually or in combination, fail to teach or suggest all the features of independent claims 14, 40, 43, and 46 as is required for a proper rejection under § 103 (see MPEP § 2142). Applicant therefore respectfully requests

reconsideration and withdrawal of the rejection under § 103 of independent claims 14, 40, 43, and 46. Applicant also requests reconsideration and withdrawal of the § 103 rejection of dependent claims 15, 16, 41, 42, 44, 45, 47, and 48 for at least the same reasons.

### III. Claims 69-80

Claims 69, 71, 72, 74, 75, 77, 78, and 80 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zigmond in view of Mori and Russo. Claims 70, 73, 76, and 79 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zigmond in view of Mori, Russo, and Hite. These rejections are respectfully traversed.

Generally speaking, each of independent claims 69, 72, 75, and 78 is directed toward automatically presenting a forced advertisement on user equipment. When the user equipment is turned off while the forced advertisement is being presented, the forced advertisement is automatically presented from the point at which the user equipment was turned off when the user equipment is turned back on.

Russo describes a system for replaying stored pay-per-play programs. To ensure that a viewer is only billed after substantially viewing the rented program, if "viewing is stopped and restarted, for whatever reason, including the viewing of another program on an intervening basis, the system will automatically keep track of where viewing left off, and restart from that point until such program has been viewed substantially in its entirety." (Russo, column 5, ll. 14-19).

The Examiner asserts that a combination of Zigmond, Russo, and Mori describes resuming a forced advertisement from the point of interruption when a system on which the forced advertisement was being presented is turned off and then back on. Applicant disagrees.

As a preliminary matter, applicant already provided an effective rebuttal of this rejection in Applicant's Response to Office Action filed on June 22, 2007 ("the June Response"). See the June Response, pp. 9-10. However, the Examiner failed to address the substance of applicant's rebuttal, claiming that "[a]pplicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection," and yet, repeated the rejection. Office Action, p 2. According to the MPEP, "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." MPEP § 707.07(f). The Examiner failed to satisfy this requirement.

Therefore, in order to expedite prosecution of this application, and in accordance with MPEP § 707.07(f), applicant respectfully requests that the Examiner address the substance of applicants' arguments provided below if any rejection to which this Reply is directed is repeated in the next Office Action.

As set forth in the June Response, Zigmond and Russo cannot be combined because they teach away from their combination (see MPEP § 2145 (X)(D)(2)). In particular, although both Russo and Zigmond refer to resuming interrupted media, they refer to very different media entities and teach very different approaches for doing so. The pay-per-view system in Russo is directed to a pay-per-view program that the viewer clearly desires to watch, as evidenced, for example, by the viewer's willingness to order that particular program for viewing. In keeping with this principle, Russo permits the viewer to watch other programs on an intervening basis and allows the viewer to resume viewing of the rented program at the viewer's convenience. Furthermore, in Russo, a viewer who terminates viewing of the program shortly after starting said viewing is not forced to continue viewing of the rented program. (See Russo, column 5, lines 10-33). In fact, the principle behind Russo's tracking and resuming feature is to ensure that viewers can abort viewing of programs they have not enjoyed substantially in their entirety without being billed for such programs (see Russo, column 3, lines 5-10). This is in direct contrast with Zigmond, which requires that an "aggressive channel surfer" who wishes to avoid viewing an advertisement by changing the channel be presented with the particular advertisement as the viewer progresses through the channel lineup so that the viewer is "repeatedly exposed to at least bits and pieces of the one particular advertisement." (See Zigmond, column 13, lines 28-39). Modifying Zigmond, in the manner suggested by the Examiner, to include the video resuming feature taught by Russo would require permitting an aggressive channel surfer to view other programs on an intervening basis with the advertisement, or terminate viewing of the advertisement altogether, in direct contrast with the teachings and principles of Zigmond.

When modifying prior art for the purposes of a § 103 rejection, the "proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference." MPEP § 2143.01. Because Russo cannot be combined with Zigmond without changing the principle of operation of at least one of the references, the

combination is improper and cannot form the basis of a § 103 rejection.

Thus, Zigmond, Mori, and Russo, taken individually or in combination, fail to teach or suggest all the features of independent claims 69, 72, 75, and 78 as is required for a proper rejection under § 103 (see MPEP § 2142). Applicant therefore respectfully requests reconsideration and withdrawal of the rejection under § 103 of independent claims 69, 72, 75, and 78. Applicant also requests reconsideration and withdrawal of the § 103 rejection of dependent claims 70, 71, 73, 74, 79, and 80 for at least the same reasons.

IV. Request for Full Text Translation of Mori and Aoyama

The English language translations of the Mori and Aoyama abstracts provided by the Examiner in support of the rejections fail to adequately convey the nature of the system allegedly taught in Mori and Aoyama. For example, applicant is unable to ascertain whether "CD reproducing" in Mori refers to playback of a CD or duplication of a CD. Applicant is also unable to determine if there are teachings in Mori or Aoyama that would lead away from the claimed invention or from a combination with Russo and/or Zigmond. (see MPEP § 706.02). Therefore, if the Examiner intends to maintain the § 103 rejections based on Mori and Aoyama, applicant respectfully requests that the Examiner provide English language translations of the full text with the next Office Action.

V. Conclusion

For at least the foregoing reasons, applicant respectfully submits that this application is in condition for allowance. Reconsideration and prompt allowance of this application are respectfully requested.

We believe that we have appropriately provided for fees due in connection with this submission. However, if there are any other fees due in connection with the filing of this

Response, please charge our Deposit Account No. 06-1075 under Order No. 003597-0179-101  
from which the undersigned is authorized to draw.

Dated: December 13, 2007

Respectfully submitted,

/Regina Sam/

Regina Sam

Limited Recognition No.: L0381

ROPES & GRAY LLP

1211 Avenue of the Americas

New York, New York 10036

(212) 596-9000

(212) 596-9090 (Fax)

Attorneys/Agents For Applicant